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EXAMINER

SAMS, MATTHEW C

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/006,936

Applicant(s)

CHIEN, HERMAN

Examiner

Matthew C. Sams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 and 27-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This office action is in response to the amendment filed on 5/11/2005. Claim 26 has been canceled.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 36 recites the limitation "mobile station number" in 34. There is insufficient antecedent basis for this limitation in the claim. The examiner will assume the applicant meant claim 35.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Simon et al. (US-2003/0087652 hereafter, Simon).

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Regarding claim 1, Simon teaches a communications device (Fig. 1 [200]) comprising a register configured to store a user identifier and a transmitter configured to transmit (Fig. 1 [300]) the user identifier to the network. (Page 6 [0101-0102])

Regarding claim 2, Simon teaches a register configured to store a device identifier (Page 5 [0076 & 0080]) and the transmitter is configured to transmit the device identifier to the network. (Page 6 [0101-0102])

Regarding claim 3, Simon teaches a communications device (Fig. 1 [200]) contains a processor and a user input interface configured to supply commands to the processor. (Page 5 [0073-0074])

Regarding claim 6, Simon teaches a communication device (Fig. 1 [200]) including a processor and a user input interface configured to supply commands to the processor. (Page 5 [0073-0074])

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4, 5, 7-9, 12, 13, and 27-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simon in view of Martineau (US-5,915,226).

Regarding claim 4, Simon teaches a communications device (Fig. 1 [200]) with a register configured to store a device identifier and a transmitter for transmitting the

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identifier to the network. (Page 5 [0076 & 0080] and Page 6 [0101-0102]) Simon differs from the claimed invention by not mentioning a subscriber identity module (SIM) and a serial number assigned to the SIM. However, Martineau teaches a communication device (Fig. 1 [2]) with a user identifier associated with a serial number assigned to a SIM. (Col. 3 line 63 through Col. 4 line 38) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate the user identifier associated with a serial number of Martineau with communications device of Simon. One of ordinary skill would have been motivated to do this since the serial number is stored on a SIM, which would be required to make Simon's communication device compatible with GSM networks. (Martineau Col. 2 lines 1-19)

Regarding claim 5, Simon in view of Martineau teaches an encryption and decryption of the device identifier and user identifier before transmission to the communication network. (Martineau Col. 8 lines 15-24)

Regarding claim 7, Simon in view of Martineau teaches a cell phone (Simon Fig. 1 [200]) comprising a display configured to display data and commands (Simon Page 5 [0073-0074]), a user input interface for data entry and command entry (Simon Page 5 [0073-0074]), a SIM that includes a user identifier (Martineau Col. 3 line 63 through Col. 4 line 38) and a transmitter configured to transmit the user identifier. (Simon Pages 6 & 7 [0106-0108])

Regarding claim 8, Simon in view of Martineau teaches memory configured to store a device identifier and a transmitter to transmit the device identifier. (Simon Page 5 [0076 & 0080] and Pages 6 through 7 [0106-0108])

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Regarding claim 9, Simon in view of Martineau teaches a user identifier that is associated with a SIM serial number. (Martineau Col. 2 lines 11-19)

Regarding claim 12, Simon in view of Martineau teaches a SIM for a wireless network comprising memory to retain the SIM identifier and a processor to supply the SIM identifier to a communications device. (Martineau Col. 4 lines 39-61)

Regarding claim 13, Simon in view of Martineau teaches a processor configured to provide a hash of the SIM identifier to the communications device. (Martineau Col. 4 lines 39-61 and Col. 8 lines 15-24)

Regarding claim 27, Simon in view of Martineau teaches a communication device that has a register configured to store a mobile station number and the transmitter is configured to transmit the mobile station number and the user identifier to a network. (Simon Page 5 [0076 & 0080] and Page 6 [0101-0102] and Martineau Col. 3 line 63 through Col. 4 line 38)

Regarding claim 28, Simon in view of Martineau obviously teaches a mobile station number is a MSISDN because without a MSISDN, the mobile user would not have a phone number. The mobile device has to have a phone number programmed into memory and has to communicate the number with the network in order to function as a cellular phone.

Regarding claim 29, Simon in view of Martineau teaches a SIM that has a user identifier associated with a serial number assigned to the SIM. (Martineau Col. 3 line 63 through Col. 4 line 61)

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Regarding claim 30, Simon in view of Martineau teaches a register that is configured to store a mobile subscriber identity and the transmitter is configured to transmit the mobile subscriber identity to the network. (Martineau Col. 2 lines 1-39)

Regarding claim 31, Simon in view of Martineau teaches a mobile subscriber identity is an international mobile subscriber identity (IMSI). (Martineau Col. 2 lines 1-39)

Regarding claim 32, Simon in view of Martineau teaches a register is configured to store a mobile subscriber identity and the transmitter is configured to transmit the mobile subscriber identity to the network. (Martineau Col. 2 lines 1-39)

Regarding claim 33, the limitations of claim 33 are rejected as the same reason set forth above in claim 31.

Regarding claim 34, the limitations of claim 34 are rejected as the same reason set forth above in claim 29.

Regarding claim 35, Simon in view of Martineau teaches a SIM comprising memory configured to store an anonymous user identity based on serial number of a SIM and at least one of the mobile subscriber identity and a mobile station number. (Martineau Col. 2 lines 1-39 and Col. 3 line 63 through Col. 4 line 61)

Regarding claim 36, the examiner is assuming a typo and the dependency should be claim 35, not claim 34. The limitations of claim 34 are rejected as the same reason set forth above in claim 28.

Regarding claim 37, Simon in view of Martineau teaches a mobile subscriber identity is an IMSI. (Martineau Col. 2 lines 1-39)

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8. Claims 10, 11, and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simon in view of Brebner (US 2001/0016906).

Regarding claim 10, Simon teaches mobile communication devices configured to communicate with content providers, but differs from the claimed invention by not mentioning the content providers comprise a content personalization interface configured to receive an anonymous user identifier from at least one of the mobile stations. However, Brebner teaches a content provider (Fig. 1 [3]) configured to communicate with one or more mobile stations (Fig. 1 [1 & 2]), comprising a content personalized interface that receives an anonymous user identifier from the mobile terminal. (Fig. 2 and Page 1 [0010] through Page 2 [0015]) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to use the content provider of Brebner with the mobile communication devices of Simon. One of ordinary skill would have been motivated to do this since it keeps personal information private but yet allows for multiple profiles and for content to be personalized to the relevant information provided in the user's profile. (Page 1 [0010-0012])

Regarding claim 11, Simon in view of Brebner teaches a processor configured to deliver content to at least one mobile station based on the anonymous user identifier. (Brebner Page 1 [0011] through Page 2 [0014])

Regarding claim 14, Simon in view of Brebner teaches a content provider (Brebner Fig. 1 [3]) comprising a personalization interface configured to receive anonymous personalization data a processor configured to provide content to a user based on the anonymous personalization data. (Brebner Fig. 2 and Page 1 [0010] through Page 2 [0015])

Regarding claim 15, Simon in view of Brebner teaches a database configured to store personalization data is well known in the art. (Brebner Page 1 [0007])

Regarding claim 16, Simon in view of Brebner teaches the personalization interface is configured to receive anonymous personalization data associated with an HTTP header. (Brebner Page 1 [0011-0012])

Regarding claim 17, Simon in view of Brebner teaches the personalization interface is configured to receive anonymous personalization data that includes a device identifier and the processor provides device-specific content based on the device identifier. (Brebner Page 2 [0025] through Page 3 [0032])

Regarding claim 18, Simon in view of Brebner teaches the personalization interface is configured to receive anonymous personalization data from the mobile station. (Brebner Page 3 [Table]) The examiner's interpretation is if the user wishes to stay anonymous at Brebner teaches on page 6 [0063], then that affects the amount of personal data the user provides to the profile.

9. Claims 19-23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simon in view of Martineau as applied to claim 4 above, and further in view of Brebner.

Regarding claim 19, Simon in view of Martineau teaches a user identifier that is stored on a SIM. (Simon Page 5 [0076 & 0080] and Page 6 [0101-0102] and Martineau Col. 3 line 63 through Col. 4 line 38) Simon in view of Martineau differ from the claimed invention by not teaches a personalization interface. However, Brebner teaches the personalization interface is configured to receive a user identifier that is stored on the client device. (Fig. 1 [1] and Page 1 [0010] through Page 2 [0015]) At the time the

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invention was made, it would have been obvious to one of ordinary skill in the art to use the content provider of Brebner with the mobile communication devices of Simon in view of Martineau. One of ordinary skill would have been motivated to do this since mobile GSM devices store personal information (i.e. user identifier) on SIM cards and Brebner's content provider receives the personal information from the client device. (Fig. 1 [1] and Page 1 [0010] through Page 2 [0015])

Regarding claim 20, Martineau teaches a communication device (Fig. 1 [2]) with a user identifier associated with a serial number assigned to a SIM. (Col. 3 line 63 through Col. 4 line 38)

Regarding claim 21, Simon in view of Martineau and Brebner teaches a method of providing an anonymous user identifier and selecting content based on the user identifier. (Brebner Fig. 1 [1 & 12], Fig. 2 and Page 1 [0010] through Page 2 [0015])

Regarding claim 22, Simon in view of Martineau and Brebner teaches a user identifier that is selected based on a SIM. (Martineau Col. 3 line 63 through Col. 4 line 38)

Regarding claim 23, Simon in view of Martineau and Brebner teaches selecting a device identifier. (Simon Page 5 [0076 & 0080])

Regarding claim 25, Simon in view of Martineau and Brebner teaches a method of obtaining anonymous personalized content by selecting an anonymous user identifier based on a serial number assigned to a SIM and identifying content for delivery based on the anonymous user identifier. (Martineau Col. 3 line 63 through Col. 4 line 38 and Brebner Page 1 [0010] through Page 2 [0015])

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10. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Simon in view of Martineau and Brebner as applied to claim 23 above, and further in view of Babu et al. (US-6,122,639 hereafter, Babu).

Regarding claim 24, Simon in view of Martineau and Brebner teaches the limitations of claim 23, but differs from the claimed invention by not mentioning a comparing of the device identifier and the user identifier with a set of user profiles and selecting content based on a user profile. Although Brebner's invention tries to minimize the amount of centralized databases, Brebner acknowledges that the centralized databases are used quite frequently (Page 1 [0007]) and the entire range of facilitating and personalizing services does not fall within the scope of his invention. (Page 3 [0032]) Therefore, it is possible to incorporate a centralized database into the combination of Simon in view of Martineau and Brebner. Babu teaches a method of providing personalized content in a wireless communication network comprising comparing the device identifier and the user identifier with a set of user profiles and selecting content based on the selected user profile. (Col. 2 line 62 through Col. 3 line 10) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to use the network information collection device of Babu with the content providers and mobile devices of Simon in view of Martineau and Brebner. One of ordinary skill in the art would have been motivated to do this because having a centralized database makes it possible to link together profiles with similar interests.

Response to Arguments

11. Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew C. Sams whose telephone number is (571)272-8099. The examiner can normally be reached on M-F 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (571)272-7499. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MCS
7/23/2005


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